



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,580	04/14/2004	Richard Paul Ejzak	29250-002031/US	6232

7590 01/17/2007
HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 8910
Reston, VA 20195

EXAMINER

BALAOING, ARIEL A

ART UNIT	PAPER NUMBER
----------	--------------

2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/823,580	EJZAK, RICHARD PAUL	
	Examiner	Art Unit	
	Ariel Balaoing	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 22-27, 32-34 and 37-42 is/are rejected.
- 7) ☒ Claim(s) 28-31, 35 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/2006 has been entered.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 22-26, 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over EJZAK (EP 1182900 A10) in view of SUNDAR et al (US 2003/0134638 A1).

Regarding claim 22, EJZAK discloses a method of transferring a packet switched call carried over a first network **110** to a circuit switched call carried over a second network **120**, the packet switched call being between a mobile station **140** and an end point **130**, **132**, **136**, comprising: establishing, at a packet call controller **150**, **152**, **154**, a bearer path between the end point and the second network when a call transfer request associated with the mobile station is received (paragraph 12-14, 16, 22, 38, 41-44). However, EJZAK does not expressly disclose wherein the call transfer request is received from the second network. In the same field of the endeavor, SUNDAR discloses wherein a call transfer request is received from a second network (**1206-1214**

Art Unit: 2617

Figure 12; **1902-1914** Figure 19; paragraph 24-27). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify EJZAK to include a call transfer request from a second network, since a decision to transfer an ongoing call to and from legacy systems could be determined using a variety of methods well known in the art of handover.

Regarding claim 23, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK and SUNDAR further discloses wherein the call transfer request is a call request including an identifier provided by the mobile station that identifies the call request as a call transfer request (see *Sunder* - paragraph 22-23, 73-76; SIP registration and SIP message).

Regarding claim 24, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK and SUNDAR further discloses wherein the identifier is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call (see *Sunder* - paragraph 22-23, 73-76, 98; SIP registration, SIP message, TLDN).

Regarding claim 25, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK and SUNDAR further discloses wherein the identifier is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call (see *Sunder* - Figure 30; paragraph 98).

Regarding claim 26, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK and SUNDAR further

Art Unit: 2617

discloses wherein the unique identifier is a public telecommunication number assigned to the mobile station for use in the second network (see *Sunder* – Figure 30; paragraph 98).

Regarding claim 37, EJZAK further discloses a method of transferring a packet switched call carried over a first network **110** to a circuit switched call carried over a second network **120** (abstract), comprising: sending a call transfer request associated with a mobile station **140** involved in the packet switched call when a call origination request for a circuit switched call on the second network is received (paragraph 12-14, 16, 22, 38, 41-44). However, EJZAK does not expressly disclose wherein the call transfer request is sent from the second network. In the same field of the endeavor, SUNDAR discloses wherein a call transfer request is sent from a second network (**1206-1214** Figure 12; **1902-1914** Figure 19; paragraph 24-27). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify EJZAK to include a call transfer request from a second network, since a decision to transfer an ongoing call to and from legacy systems could be determined using a variety of methods well known in the art of handover.

Regarding claim 38, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK and SUNDAR further discloses wherein the call transfer request is a call request including an identifier provided by the mobile station that identifies the call request as a call transfer request (see *Sunder* - paragraph 22-23, 73-76; SIP registration and SIP message).

Regarding claim 39, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK and SUNDAR further discloses wherein the identifier is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call (*see Sunder* - paragraph 22-23, 73-76, 98; SIP registration, SIP message, TLDN).

Regarding claim 40, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK and SUNDAR further discloses wherein the identifier is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call (*see Sunder* - Figure 30; paragraph 98).

Regarding claim 41, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK and SUNDAR further discloses wherein the unique identifier is a public telecommunication number assigned to the mobile station for use in the second network (*see Sunder* - Figure 30; paragraph 98).

4. Claims 27 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over EJZAK (EP 1182900 A10) in view of SUNDAR et al (US 2003/0134638 A1) in further view of BOS et al (US 2004/0008669 A1).

Regarding claim 27 and 42, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although the combination of EJZAK and SUNDAR disclose the use of session initiation protocol, the combination of EJZAK and SUNDAR does not express disclose wherein the call request is a SIP INVITE request.

Art Unit: 2617

In the same field of the endeavor, BOS discloses wherein the call request is a SIP INVITE request (paragraph 52, 74; invitation is sent to the gateway using SIP protocol after SIP REFER message). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of EJZAK and SUNDAR to include the teachings of BOS, since the use of session initiation protocol is well known in the art.

5. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over EJZAK (EP 1182900 A10) in view of SUNDAR et al (US 2003/0134638 A1) in view of BOS et al (US 204/0008669 A1) and KALLIO et al (US 2004/0190498 A1).

Regarding claim 32, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although the combination of EJZAK and SUNDAR discloses the use of session initiation protocol, the combination of EJZAK and SUNDAR does not disclose wherein the establishing step comprises: receiving a SIP INVITE request; determining whether the SIP INVITE request requests transfer of the packet switched call on the first network to a circuit switched call on the second network; and setting up the bearer path between the end point and the second network when the determining step determines that the SIP INVITE request does request transfer. BOS discloses wherein the establishing step comprises: receiving a SIP INVITE request (paragraph 52-54, 65, 82); determining whether the SIP INVITE request requests transfer of the packet switched call on the first network to a circuit switched call on the second network (paragraph 52-54, 65, 82); and setting up the bearer path between the end point and the second network when the determining step determines that the SIP

Art Unit: 2617

INVITE request does request transfer (paragraph 52-54, 65, 82). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination EJZAK and SUNDAR to include the teachings of BOS, since the use of SIP INVITE messages to established call connection is necessary when using session initiation protocol standards. However, the combination of EJZAK, SUNDAR, and BOS does not expressly disclose wherein the SIP INVITE includes a request URI; and wherein the determination is based on the request URI. KALLIO discloses wherein the SIP INVITE includes a request URI; and wherein the determination is based on the request URI (paragraph 50-52). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of EJZAK, SUNDAR and BOS to include a URI, as taught by KALLIO, since the use of a universal resource identifier to determine a call participants address is well known and conventional in the art.

Regarding claim 33, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK, SUNDAR, BOS and KALLIO discloses wherein the determining step determines that the SIP INVITE request does request transfer when the Request URI is a public identifier provided for use by mobile stations to request call transfer of an ongoing packet switched call (see *KALLIO* paragraph 50-52).

Regarding claim 34, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of EJZAK, SUNDAR, BOS and KALLIO discloses wherein the determining step determines that the SIP INVITE request

Art Unit: 2617

does request transfer when the Request URI is a unique identifier associated with the mobile station for use in requesting call transfer of an ongoing packet switched call (see *KALLIO* paragraph 50-52).

Allowable Subject Matter

6. Claims 28-31, 35, 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 28, the prior art of record does not disclose wherein the establishing step comprises: sending a call control request to the end point requesting agreement to transition the packet call controller from a call control agent for a first call control path from the first network to the end point to a call control agent for a second call control path from the second network to the end point.

Regarding claim 35, the prior art of record does not disclose wherein the establishing step further comprises: sending a SIP re-INVITE request to the end point requesting agreement to transition the packet call controller from a call control agent for a first call control path from the first network to the end point to a call control agent for a second call control path from the second network to the end point; and wherein the setting up step is performed by the packet call controller as the call control agent for the second call control path.

Art Unit: 2617

Regarding claim 36, the prior art of record does not disclose further comprising: serving as a proxy for the packet switched call prior to the receiving step; accumulating information regarding the packet switched call while serving as the proxy; and wherein the determining step determines that the SIP INVITE request does request transfer based on at least the accumulated information and the Request URI.

Claims 29-31 are allowable for being dependent on allowable subject matter.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

SAGI et al (US 2004/0264410 A1) – Apparatus for providing a communication unit with a handoff between networks.

EJZAK (US 2003/0027595 A1) – Provision of services in a communication system including an interworking mobile switching center.

KUUSINEN et al (US 2005/0083909 A1) – Establishing circuit-switched communications via packet-switched network signaling.

PECAN et al (US 2005/0227691 A1) – Handover request from secondary network during an ongoing communication.

DANTU et al (US 2006/0140151) – Wireless-specific services for a wireless access network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-

Art Unit: 2617

7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ariel Balaoing – AU2617

AB 1/5/7

AB



LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER